

Appl. No. : 09/421,870
Filed : October 26, 1999

REMARKS

In response to the Office Action, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments. Claims 7-9, 11-12, 23, 55, 63-66, 68, 75-77, 81-152, and 204-208 are canceled, Claims 1-6, 10, 19-22, 24, 26-54, 56-62, 67, 69-74, 78-80, 156-161, and 178-186 are presented for further examination.

Discussion of the Rejection of Claims under 35 U.S.C. § 112, First Paragraph

In the Office Action, the Examiner rejected Claims 1-6, 8-12, 19-24, 26-62, 67, 69-74, 78-80, 82, 156-161, and 178-186 under 35 U.S.C. § 112 first paragraph, particularly citing that “to require a physical material deposition subsequent to manufacture” is new matter. Although Applicant traverses this rejection, the foregoing amendments herein to independent Claims 1, 22, 49, 67, 70 and 78 delete the objected to language. Accordingly, the Applicant respectfully submits that the new matter rejection is moot, and presents the amended claims for further examination.

Discussion of the Rejection of Claims under 35 U.S.C. § 112, Second Paragraph

In the Office Action, the Examiner rejected Claims 1-6, 8-12, 19-24, 26-62, 67, 69-74, 78-80, 82, 156-161, and 178-186 under 35 U.S.C. § 112 second paragraph, particularly citing “material is physically deposited ‘subsequent to manufacture’” as being indefinite. Although the Applicant traverses this rejection, the foregoing amendments to independent claims 1, 22, 49, 67, 70 and 78 delete the objected to language. Accordingly, the Applicant respectfully submits that the new matter rejection is moot, and presents the amended claims for further examination.

Discussion of the Rejection of Claims under 35 U.S.C. § 102

In the Office Action, the Examiner rejected Claims 1-6, 8-12, 19-24, 26-34, 38, 39, 48-50, 58, 61, 62, 67, 69-74, 78-80, 82, 156-161, and 178 under 35 U.S.C. § 102(e)(2) as being anticipated by U.S. Patent No. 5,872,723 (“DeCusatis”). Applicant traverses this rejection.

Appl. No. : 09/421,870
Filed : October 26, 1999

Claims 1, 22, 49, 67, 78, and 79

Applicant respectfully submits that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *See* M.P.E.P. § 2131. As a brief background, in one embodiment, micron-sized chemically reactive features (or structures) are *disposed on a surface* of an optical disc. These *chemically reactive features* disposed on a surface of an optical disk are distinct from other *structures* that are part of the optical disk itself, or those that may be manufactured into or onto an optical disk by, e.g., various photolithic processes.

The Applicant respectfully submits that DeCusatis does not expressly teach or suggest an optical disc “comprising a plurality of micron-sized chemically reactive features disposed upon an air-incident surface of said optical disc” (amended Claim 1). The “wobble structure” disclosed in DeCusatis and stated by the Examiner to be a “nonoperational structure” (as cited in the previous Office Action and maintained in the current Office Action) is a typical track on an optical disk. The track in DeCusatis is merely used in the calculation of the difference between two measured focal planes of a disc to determine the variability of the laser light in the Z direction to detect wobble in the drive and spindle mechanism and does not close or suggest the limitations cited above. (*See* DeCusatis col. 30, lines 33-65). Specifically, in DeCusatis, the tracks on the optical disc that are used for the wobble calculation are *inside* at least one layer of the disc, not on an outside surface exposed to air, or “air-incident” as required in amended Claim 1 (see, e.g., DeCusatis Figure 3, 34 and Figure 4, 34a, 34b). Additionally, DeCusatis fails to disclose a chemically reactive feature disposed on the surface of the disc. Accordingly, Applicant respectfully submits that since DeCusatis does not teach or suggest each and every element of amended Claim 1 for at least these reasons, and thus amended Claim 1 is not anticipated and is in condition for allowance.

Amended Claims 22, 49, 67, 70, 78, and 79 also include at least one limitation related to those discussed above for Claim 1 that DeCusatis fails to disclose. For example, Claim 22 requires “at least one micron-sized chemically reactive feature disposed upon an air-incident surface of said disc in said information layer, wherein said at least one chemically reactive feature is disposed confocally with said the trackable structure.” Claim 49 requires “a plurality of chemically reactive features.” Claim 67 requires “disposing a plurality of chemically reactive features confocally with, and laser proximal to, said trackable operational structure.” Claim 70

Appl. No. : 09/421,870
Filed : October 26, 1999

requires disposing a plurality of chemically reactive features disposed on the disc-proximal side of a light transmissive cover.” Claims 78 and 79 require “a plurality of chemically reactive features disposed confocally with said operational structure.” Accordingly, Applicant respectfully submits that DeCusatis does not teach or suggest each and every element of amended Claims 22, 49, 67, 70, 78 and 79. Therefore, for at least these reasons, Applicant respectfully submits Claims 22, 49, 67, 70, 78 and 79 are not anticipated and are in condition for allowance.

Claims 2 – 6, 19, 20 – 21, 24, 26, 27 – 29, 33 – 37, 50 – 60, and 69 are dependent directly or indirectly on the above-discussed Claims 1, 22, 49, 67, 78, and 79. Accordingly, Applicant respectfully submits that amended Claims 2 – 6, 19, 20 – 21, 24, 26, 27 – 29, 33 – 37, 50 – 60, and 69 are also in condition for allowance for at least the same reasons.

Claim 71

In the Office Action, the Examiner rejected Claim 71 as being anticipated by disclosure in DeCusatis relating to making of optical discs (col. 4, lines 10-14, and col. 10, line 6 through col. 13, line 7). After careful examination of DeCusatis, Applicant respectfully submits that Claim 71 is not anticipated by DeCusatis because each and every element as set forth in the amended claim is not found, either expressly or inherently. The method of amended Claim 71 requires “using an optical disc reader to read a chemically reactive feature of a disc, the method comprising trackably reading the optical disc of any one of claim 1 or claim 22 in said reader.” The Applicant has amended Claims 1 and 22 herein. Therefore, Claim 71 at least requires using an optical disc reader to read a “micron-sized chemically reactive features disposed upon an air-incident surface of said disc” (a limitation of Claim 1) or a “micron-sized chemically reactive feature disposed upon an air-incident surface of said disc in said information layer, wherein said at least one chemically reactive feature is disposed confocally with said the trackable structure” (a limitation of Claim 22). As discussed above, DeCusatis at least fails to disclose or suggest a method of using an optical disc reader to read such chemically reactive features on an optical disc, instead disclosing reading features (i.e., tracks, pits, etc.) commonly found on optical disks.

Accordingly, Applicant respectfully submits that DeCusatis does not teach or suggest each and every element of amended Claim 71. Therefore, for at least these reasons, Applicant respectfully submits Claim 71 is not anticipated and is in condition for allowance.

Appl. No. : 09/421,870
Filed : October 26, 1999

Claims 2 – 6, 19, 20 – 21, 24, 26, 27 – 29, 33 – 37, 50 – 60, and 69 are dependent directly or indirectly on the above-discussed Claims 1, 22, 49, 67, 78, and 79. Accordingly, Applicant respectfully submits that amended Claims 2 – 6, 19, 20 – 21, 24, 26, 27 – 29, 33 – 37, 50 – 60, and 69 are also in condition for allowance for at least the same reasons.

Claims 38, 62, and 156

In the Office Action, the Examiner cites two focusing lenses in DeCusatis as anticipating the “cover” of Claim 38. (DeCusatis Figure 22, **71** and **72**). As disclosed by Figure 22 and corresponding description, both of these lenses are part of a system that reads the optical disc. Lenses **71** and **72** not attached or attachable to the optical disk disclosed in DeCusatis, as required in amended Claim 38. Additionally, Claim 38 is amended to clarify that the cover is “attachable to said optical disc such that said cover rotates with the rotation of said optical disk,” a limitation that DeCusatis also fails to disclose or suggest. DeCusatis fails to disclose or teach that lenses **71** and **72** rotate, instead, they are fixed and the optical disc **30** moves past each lens. Accordingly, Applicant respectfully submits that DeCusatis does not teach or suggest each and every element of amended Claim 38. Therefore, for at least these reasons, Applicant respectfully submits Claim 38 is not anticipated and is in condition for allowance.

The limitations of Claim 62 include “an optical disc assembly according to Claim 38.” As discussed above, DeCusatis fails to disclose all the limitations of said optical disk assembly. Therefore, for at least the same reasons as discussed for Claim 38, Applicant respectfully submits Claim 62 is not anticipated and is in condition for allowance.

The limitations of Claim 156 include “a cover removably attached to said optical disc.” As previously discussed for Claim 38, DeCusatis fails to disclose or suggest this limitation. Therefore, for at least the same reasons as discussed for Claim 38, Applicant respectfully submits Claim 156 is not anticipated and is in condition for allowance.

Claims 39 – 48, 157 – 161 and 178 – 186 are dependent directly or indirectly on the above-discussed Claims 38 and 156. Accordingly, Applicant respectfully submits that amended Claims 39 – 48, 157 – 161, and 178 – 186 are also in condition for allowance for at least the same reasons.

Appl. No. : 09/421,870
Filed : October 26, 1999

CONCLUSION

The applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes pursuant to statutory sections 102 and/or 112, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. In light of these amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. Furthermore, any new claims presented above are of course intended to avoid the prior art, but are not intended as replacements or substitutes of any canceled claims. They are simply additional specific statements of inventive concepts described in the application as originally filed.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: October 28, 2004

By: 
Gregory A. Hermanson
Registration No. 53,018
Attorney of Record
Customer No. 20,995
(619) 235-8550